

United States District Court

Northern DISTRICT OF

HOME DIAGNOSTICS, INC., a Delaware
corporation,

SUMMONS IN A CIVIL ACTION

v.

CASE NUMBER: C -

LIFESCAN, INC., a California corporation,

C01-20725JW

ADR PVT

TO: (Name and address of defendant)

LIFESCAN, INC.
c/o of CT Corporation System, Inc.
Agent of Service for Defendant LifeScan, Inc.
818 W. 7th Street, Floor 2
Los Angeles, CA 90017-3407

YOU ARE HEREBY SUMMONED and required to serve upon **PLAINTIFF'S ATTORNEY** (name and address)

Scott R. Mosko, Esq.
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
700 Hansen Way
Palo Alto, CA 94304-1016

an answer to the complaint which is herewith served upon you, within twenty (20) days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. You must also file your answer with the Clerk of this Court within a reasonable period of time after service.

RICHARD W. WIEKING

JUL 31 2001

CLERK

DATE

(BY) DEPUTY CLERK

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HOME DIAGNOSTICS, INC., a Delaware
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E-filing

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LEYVA CASTILLO

(BY) DEPUTY CLERK

CIVIL COVER SHEET

JS 44 - No. CALIF (Rev. 4/97)

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON PAGE TWO)

I. PLAINTIFFS

PLAINTIFFS
H.C. DIAGNOSTICS, INC.,
a Delaware corporation,

DEFENDANTS

DEFENDANTS
LIFESCAN, INC.,
a California corporation,

(b) COUNTY OF RESIDENCE OF FIRST LISTED PLAINTIFF _____
(EXCEPT IN U.S. PLAINTIFF CASES)

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT _____
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

(c) ATTORNEYS (FIRM NAME, ADDRESS, AND TELEPHONE NUMBER)

Scott R. Mosko - Bar No. 106070
Finnegan, Henderson, Farabow, Garrett & D
700 Hansen Way
Palo Alto, CA 94304
650-849-6600

ATTORNEYS (IF KNOWN)

Quinn, Emanuel, Urquhart, Oliver & Hedges
201 Sansome Street, Sixth Floor
San Francisco, CA 94104-2303
Telephone: (415) 986-5700

II. BASIS OF JURISDICTION (PLACE AN 'X' IN ONE BOX ONLY)

- ☐ 1 U.S. Government Plaintiff
☐ 2 U.S. Government Defendant
☒ 3 Federal Question (U.S. Government Not a Party)
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (PLACE AN 'X' IN ONE BOX FOR PLAINTIFF AND ONE BOX FOR DEFENDANT)

(For diversity cases only)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. ORIGIN

(PLACE AN 'X' IN ONE BOX ONLY)

- ☒ 1 Original Proceeding
☐ 2 Removed from State Court
☐ 3 Remanded from Appellate Court
☐ 4 Reinstated or Reopened
☐ 5 Transferred from Another district (specify) _____
☐ 6 Multidistrict Litigation
☐ 7 Appeal to District Judge from Magistrate Judgment

V. NATURE OF SUIT (PLACE AN 'X' IN ONE BOX ONLY)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury PERSONAL PROPERTY <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 RR & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS - Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce/ICC Rates/etc. <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes <input checked="" type="checkbox"/> 890 Other Statutory Actions
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motion to Vacate Sentence Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition		

VI. CAUSE OF ACTION (CITE THE US CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE. DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY) Declaratory Judgment as a result of threatened litigation.

VII. REQUESTED IN COMPLAINT: ☐ CHECK IF THIS IS A CLASS ACTION DEMAND \$ _____ UNDER F.R.C.P. 23

☐ CHECK YES only if demanded in complaint:
JURY DEMAND: ☒ YES ☐ NO

RELATED CASE(S) IF ANY PLEASE REFER TO CIVIL L.R. 3-12 CONCERNING REQUIREMENT TO FILE "NOTICE OF RELATED CASE".

IX. DIVISIONAL ASSIGNMENT (CIVIL L.R. 3-2) (PLACE AN 'X' IN ONE BOX ONLY) ☐ SAN FRANCISCO/OAKLAND ☒ SAN JOSE

DATE

SIGNATURE OF ATTORNEY OF RECORD

July 31, 2001

Scott R. Mosko

1 Scott R. Mosko (State Bar No. 106070)
2 Robert F. McCauley (State Bar No. 162056)
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14 Washington, D.C. 20005
15 Attorneys for Plaintiff
16 HOME DIAGNOSTICS, INC.

13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 SAN JOSE DIVISION

17 HOME DIAGNOSTICS, INC.,
18 a Delaware corporation

19 Plaintiff,

20 v.

21 LIFESCAN, INC.,
22 a California corporation,

23 Defendants.

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01 JUL 31 AM 7:29

RICHARD W. WIEKING
U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

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JUL 31 2001

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE

E-filing

16 C01-20725 JW
17 ADR PVT

CASE NO. _____

COMPLAINT FOR DECLARATORY
JUDGMENT

DEMAND FOR JURY TRIAL

1 Plaintiff, Home Diagnostics, Inc. ("HDI"), alleges as follows for its declaratory judgment
2 complaint against LifeScan, Inc. ("LifeScan"):

3 **Jurisdiction and Venue**

4 1. HDI brings this civil action under the Patent Laws, Title 35 of the United States
5 Code, and under 28 U.S.C. § 2201 to obtain a declaration of noninfringement with respect to
6 LifeScan's United States Patent No. 6,268,162, sometimes hereinafter referred to as "the patent at
7 issue in this Complaint". Since this action arises under the Patent Laws of the United States, this
8 Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

9 2. Venue in this judicial district is proper under 28 U.S.C. § 1391(b) and 1400 (b).

10 **Parties**

11 3. HDI is a corporation organized and existing under the laws of Delaware, with a
12 principal place of business at 2400 N.W. 55th Court, Ft. Lauderdale, Florida, 33309.

13 4. HDI is engaged in the design, development, manufacture, marketing, and sale of
14 devices useful for measuring the level of glucose in human blood.

15 5. LifeScan is a corporation organized and existing under the laws of the State of
16 California, with a principal place of business at 1000 Gibraltar Drive, Milpitas, California 95035.

17 6. LifeScan is also engaged in the design, development, manufacturing, marketing, and
18 sale of devices useful for measuring blood glucose level, and competes with HDI.

19 **Factual Background: Declaratory Relief**

20 7. On July 31, 2001, United States Patent No. 6,268,162 issued to LifeScan.

21 8. Upon information and belief, LifeScan is the owner of the entire right, title, and
22 interest in the patent at issue in this Complaint.

23 9. LifeScan's past conduct in attempting to enforce the patent at issue in this Complaint
24 and related patents against HDI's commercial blood glucose meters evidences a pattern of
25 aggressive litigation. LifeScan first sued HDI in this Court in December of 1992, alleging that
26 HDI's then-current line of blood glucose meters sold under the name "Ultra" infringed the method
27 claimed in United States Patent No. 5,049,487 ("the '487 patent"), a patent related to the patent at
28 issue in this Complaint. See *LifeScan, Inc. v. Home Diagnostics, Inc.*, No. 92-20811 SW (N.D. Cal.

1 May 18, 1994) (“*LifeScan I*”). On HDI’s motion, this Court issued an Order granting summary
2 judgment of noninfringement in favor of HDI. On appeal, this Court’s ruling was affirmed-in-part,
3 reversed-in-part, and the case was remanded. See *LifeScan, Inc. v. Home Diagnostics, Inc.*, 76 F. 3d
4 358 (Fed. Cir. 1996).

5 10. With *LifeScan I* still pending in this Court, on December 6, 1996, LifeScan filed a
6 second lawsuit on the ‘487 patent against HDI-this time in a different court (the U.S. District Court
7 for the District of Delaware) and with respect to a new HDI product, the “Prestige” meter. See
8 *LifeScan v. Home Diagnostics, Inc. et al.*, No. 96-597 (JJF) (“*LifeScan II*”). In *LifeScan II*, LifeScan
9 alleged that use of the Prestige meter directly infringed the ‘487 patent both literally and under the
10 doctrine of equivalents, and that HDI contributorily infringed and induced others to infringe the ‘487
11 patent. After a jury verdict of infringement based on the doctrine of equivalents, on June 21, 2000,
12 the Delaware District Court granted HDI Judgment as a Matter of Law, ruling that no reasonable
13 juror could have found infringement, either literally or under the doctrine of equivalents. On April
14 6, 2001, the Federal Circuit Court of Appeals affirmed the Judgment in HDI’s favor.

15 11. Shortly before the start of trial in *LifeScan II*, LifeScan attempted to amend the
16 complaint to allege that the Prestige meter and its use infringed United States Patent No. 5,849,692
17 (“the ‘692 patent”), another patent related to patent at issue in this Complaint. The Delaware Court
18 denied LifeScan’s motion to amend its complaint concerning the ‘692 patent.

19 12. On December 30, 1999, HDI filed a declaratory judgment action in the Northern
20 District of California seeking an order that HDI’s commercial blood glucose meters, the Prestige and
21 new products the Prestige LX and the Prestige Smart System, do not infringe LifeScan’s ‘487 or
22 ‘692 patents. LifeScan responded by filing a counterclaim against HDI for infringement of its ‘487
23 and ‘692 patents. See *Home Diagnostics, Inc. v. LifeScan, Inc.* No. C-99 21269 (JW) (RS).
24 (*LifeScan III*).

25 13. In *LifeScan III*, on October 26, 2000, this Court issued an order holding that LifeScan
26 was precluded from bringing an action against HDI on its ‘487 patent based on the Delaware District
27 Court’s judgment of noninfringement and the collateral estoppel doctrine.
28

1 14. Also in *LifeScan III*, LifeScan stated in a case management conference statement,
2 filed on or about March 9, 2001, that “[it] expects to file a motion to amend its Answer and
3 Counterclaim to add a claim for infringement of its soon to be issued patent, which patent is part of
4 the same patent family as the 487 and 692 Patents.” HDI is informed and believes that this “soon to
5 be issued patent” is the patent at issue in this Complaint.

6 15. Also in *LifeScan III*, on April 23, 2001, this Court granted HDI’s motion for summary
7 judgment, finding that as a matter of law HDI’s commercial blood glucose meters, the Prestige, the
8 Prestige LX and the Prestige Smart System, do not infringe LifeScan’s ‘692 patent.

9 First Count: Declaratory Judgment of
10 Noninfringement of the Patent at Issue in this Complaint

11 16. HDI incorporates the allegations of paragraphs 1 - 15.

12 17. In view of LifeScan’s demonstrated willingness to assert each of its admittedly
13 related patents to the patent at issue in this Complaint against HDI concerning its commercial blood
14 glucose meters, and LifeScan’s admission in the case management conference statement in *LifeScan*
15 *III* that it would amend its complaint to assert infringement of its “soon to be issued patent”, HDI
16 understands, is apprehensive of, and fully believes and expects that LifeScan intends to bring an
17 action asserting HDI’s commercial blood glucose meters infringe the patent at issue in this
18 Complaint.

19 18. There is an actual controversy between HDI and LifeScan as to the infringement of
20 the patent at issue in this Complaint because LifeScan has expressly charged and is expressly
21 charging that HDI’s commercial blood glucose meters are infringing.

22 19. The patent at issue in this Complaint is not infringed by use of HDI’s commercial
23 blood glucose meters, either literally or under the doctrine of equivalents. HDI is not inducing and
24 has not induced users of its commercial blood glucose meters to infringe the patent at issue in this
25 Complaint. Nor has HDI contributed to the infringement of the patent at issue in this Complaint. A
26 judicial declaration of this noninfringement is needed. Therefore, by this claim for relief, HDI seeks
27 a declaration that the use of its commercial blood glucose meters does not infringe any claim of the
28

1 patent at issue in this Complaint, and that HDI is not liable for inducing or contributing to
2 infringement of any claim of the patent at issue in this Complaint.

3 Second Count: Declaratory Judgment of
4 Invalidity of the Patent at Issue in this Complaint

5 20. HDI incorporates the allegations of paragraphs 1 - 19.

6 21. The patent at issue in this Complaint is invalid under one or more provisions of Title
7 35 of the United States Code. Therefore, by this claim for relief, HDI seeks a declaration that the
8 Patent at issue in this Complaint is invalid.

9 Prayers for Relief

10 WHEREFORE, HDI prays that:

11 (a) A declaratory judgment be entered adjudging and declaring that use of HDI's
12 commercial blood glucose meters does not infringe any claim of the patent at issue in this
13 Complaint, that HDI is not liable for inducing users of its commercial blood glucose meters to
14 infringe any claim of the patent at issue in this Complaint, and that HDI is not liable for contributing
15 to infringement of any claim of the patent at issue in this Complaint;

16 (b) A permanent injunction be entered enjoining LifeScan, its officers, agents, directors,
17 servants, employees, subsidiaries, assignees, and all those acting under the authority or in privity
18 with them or with any of them who receive actual notice of the injunction, from asserting or
19 otherwise seeking to enforce the patent at issue in this Complaint against HDI's commercial blood
20 glucose meters;

21 (c) An Order be entered requiring LifeScan to notify in writing each person whom
22 LifeScan and/or its attorneys have contacted regarding any allegations of infringement of the patent
23 at issue in this Complaint that use of HDI's commercial blood glucose meters do not infringe any
24 claim of the patent at issue in this Complaint, that HDI has not induced users of its commercial
25 blood glucose meters to infringe any claim of the patent at issue in this Complaint, and that HDI has
26 not contributed to infringement of any claim of the patent at issue in this Complaint;

27 (d) A declaratory judgment be entered adjudging and declaring that the patent at issue in
28 this Complaint is invalid and unenforceable;

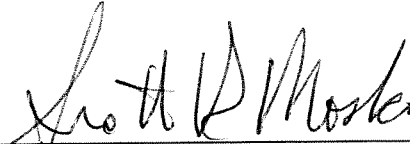
1 (e) HDI be awarded its attorneys' fees, costs, and expenses incurred in this action; and

2 (f) HDI be granted such other and further relief as the Court deems just, equitable, and

3 proper.

4 Dated: July 31, 2001

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

5
6
7 By: 
8 Scott R. Mosko, Attorneys for Plaintiff
Home Diagnostics, Inc.

CERTIFICATION OF INTERESTED ENTITIES OR PERSONS

Pursuant to Civil L.R. 3-16, the undersigned certifies that as of this date, and to the best of his knowledge, there is no such interest to report.

Dated: July 31, 2001

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: Scott R. Mosko
Scott R. Mosko, Attorneys for Plaintiff
Home Diagnostics, Inc.

JURY DEMAND

Plaintiff Home Diagnostics, Inc. demands a jury trial as to all issues so triable in this action.

Dated: July 31, 2001

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

By: Scott R. Mosko
Scott R. Mosko, Attorneys for
Plaintiff, Home Diagnostics, Inc.

1 Scott R. Mosko (State Bar No. 106070)
2 Robert F. McCauley (State Bar No. 162056)
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10 Of Counsel:

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18 Washington, D.C. 20005

19 Attorneys for Plaintiff
20 HOME DIAGNOSTICS, INC.

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23 SAN JOSE DIVISION

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C01-20725

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PVT

CASE NO. C -
NOTICE OF RELATED CASE

1 Pursuant to Civil L. R. 3-12, Plaintiff Home Diagnostics, Inc. (“HDI”) brings the attention of
2 this Court to *Home Diagnostics, Inc. v. LifeScan, Inc.*, Civil No. 99-21269 JW (“*HDI 1*”), a case that
3 was previously pending before the Honorable James Ware.

4 HDI and Defendant LifeScan, Inc. (“LifeScan”) manufacture and sell commercial blood
5 glucose meters. Judge Ware presided over *HDI 1*, in which LifeScan asserted that HDI’s
6 commercial blood glucose meters infringe two of LifeScan’s patents. The current case concerns yet
7 another patent that LifeScan admits is in the same family as those at issue in *HDI 1*, and involves
8 nearly identical devices. More specifically, LifeScan patents, United States Letters Patent No.
9 5,049,487 (“the ‘487 patent”) and United States Letters Patent No. 5,843,692 (“the ‘692 patent”) stem
10 from and claim priority to the same original patent application, and together claim methods and an
11 apparatus for measuring the concentration of an analyte, such as glucose, in a fluid, such as blood.
12 In *HDI 1*, LifeScan alleged claims that HDI’s commercial blood glucose meters infringed both the
13 ‘487 and ‘692 patents. Indeed, LifeScan itself admitted that the patent currently at issue was directly
14 related to those that were before Judge Ware in *HDI 1*. In a Joint Case Management Conference
15 Statement, filed on or about March 9, 2001, LifeScan represented that this new patent was “part of
16 the same patent family as the ‘487 and ‘692 patents.” Thus, LifeScan argued that Judge Ware
17 should allow it to amend its counterclaim to add this new patent to *HDI 1*, once the new patent
18 issued. The Court never acted on LifeScan’s request because on April 23, 2001, it granted summary
19 judgment in favor of HDI before LifeScan’s new admittedly-related patent issued. It is this “new
20 patent” that is at issue in this action.

21 In *HDI 1*, the Court was asked to determine whether HDI’s commercial blood glucose meters
22 infringe the ‘487 patent and the ‘692 patent. Like Judge Ware did in *HDI 1*, the Judge assigned to
23 the present action will have to learn the relevant technology, study the teachings of the patent at
24 issue and the related ‘487 and ‘692 patents, familiarize himself or herself with the patent at issue and
25 the related ‘487 and ‘692 patents and their file wrappers, and determine the proper scope of the
26 claims of the new patent.

27 Both the present action and the related *HDI 1* case thus involve a dispute between identical
28 parties, concern a patent that LifeScan admits derived from the same family of patents with which

1 Judge Ware has detailed familiarity, and will involve substantially the same questions of law which
2 Judge Ware recently addressed. In light of the significant commonality of both actions, assignment
3 of this case to Judge Ware is likely to conserve judicial resources and promote an efficient
4 determination of the action. Judge Ware has a level of familiarity with the parties, the admittedly
5 related '487 and '692 patents to the patent at issue in the current Complaint, and the patented
6 technology unlike any other Judge in this District. It therefore appears likely that there will be an
7 unduly burdensome duplication of labor and expense if the present action is assigned to a Judge
8 other than Judge Ware.

9 In addition to *HDI I*, there were two other cases involving a dispute between LifeScan and
10 HDI over this same family of patents. One was venued in the Delaware District court, (*LifeScan v.*
11 *Home Diagnostics, Inc.* No. 96-597 (JJF)), the other was assigned to Judge Williams of this Court
12 (*LifeScan Inc. v. Home Diagnostics, Inc.* No. 92-20811 SW). Each of these other cases has been
13 resolved.

14
15 Dated: July 31, 2001

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

16
17
18 By: 

19 Scott R. Mosko, Attorneys for Plaintiff
20 Home Diagnostics, Inc.
21
22
23
24
25
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27
28

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11 Attorneys for Plaintiff
12 HOME DIAGNOSTICS, INC.

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19 Plaintiff,

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CASE NO. C -

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8 nearly identical devices. More specifically, LifeScan patents, United States Letters Patent No.
9 5,049,487 ("the '487 patent") and United States Letters Patent No. 5,843,692 ("the '692 patent") stem
10 from and claim priority to the same original patent application, and together claim methods and an
11 apparatus for measuring the concentration of an analyte, such as glucose, in a fluid, such as blood.
12 In *HDI I*, LifeScan alleged claims that HDI's commercial blood glucose meters infringed both the
13 '487 and '692 patents. Indeed, LifeScan itself admitted that the patent currently at issue was directly
14 related to those that were before Judge Ware in *HDI I*. In a Joint Case Management Conference
15 Statement, filed on or about March 9, 2001, LifeScan represented that this new patent was "part of
16 the same patent family as the '487 and '692 patents." Thus, LifeScan argued that Judge Ware
17 should allow it to amend its counterclaim to add this new patent to *HDI I*, once the new patent
18 issued. The Court never acted on LifeScan's request because on April 23, 2001, it granted summary
19 judgment in favor of HDI before LifeScan's new admittedly-related patent issued. It is this "new
20 patent" that is at issue in this action.

21 In *HDI I*, the Court was asked to determine whether HDI's commercial blood glucose meters
22 infringe the '487 patent and the '692 patent. Like Judge Ware did in *HDI I*, the Judge assigned to
23 the present action will have to learn the relevant technology, study the teachings of the patent at
24 issue and the related '487 and '692 patents, familiarize himself or herself with the patent at issue and
25 the related '487 and '692 patents and their file wrappers, and determine the proper scope of the
26 claims of the new patent.

27 Both the present action and the related *HDI I* case thus involve a dispute between identical
28 parties, concern a patent that LifeScan admits derived from the same family of patents with which

1 Judge Ware has detailed familiarity, and will involve substantially the same questions of law which
2 Judge Ware recently addressed. In light of the significant commonality of both actions, assignment
3 of this case to Judge Ware is likely to conserve judicial resources and promote an efficient
4 determination of the action. Judge Ware has a level of familiarity with the parties, the admittedly
5 related '487 and '692 patents to the patent at issue in the current Complaint, and the patented
6 technology unlike any other Judge in this District. It therefore appears likely that there will be an
7 unduly burdensome duplication of labor and expense if the present action is assigned to a Judge
8 other than Judge Ware.

9 In addition to *HDI I*, there were two other cases involving a dispute between LifeScan and
10 HDI over this same family of patents. One was venued in the Delaware District court, (*LifeScan v.*
11 *Home Diagnostics, Inc.* No. 96-597 (JJF)), the other was assigned to Judge Williams of this Court
12 (*LifeScan Inc. v. Home Diagnostics, Inc.* No. 92-20811 SW). Each of these other cases has been
13 resolved.

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15 Dated: July 31, 2001

FINNEGAN, HENDERSON, FARABOW,
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17
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